

Application No.: 09/707269

Case No.: 53415US038

REMARKS

Upon entry of the present amendment, claims 16, 18-39, and 41-43 will be pending. Claims 40 and 44 have been canceled and claims 36, 39, and 41 have been amended. Applicants respectfully submit that the amendment places the application in condition for allowance or better form for appeal. Reconsideration of the application as amended is requested.

I. Claims 16, 18-39, and 41-43 are Not Obvious in view of Kaufman, Hudson, and Hirabayashi

Claims 16, 18-39, and 41-43 stand rejected under 35 USC § 103(a) as allegedly being obvious over Kaufman et al. (U.S. 5,954,997) in view of Hudson (U.S. 5,972,792) or in view of Hirabayashi, et al. (U.S. 5,575,885). Applicants request reconsideration of this rejection because the combination of Kaufman, Hudson, and Hirabayashi does not teach or suggest a working liquid that comprises a buffer, as recited in Applicants' claims.

Kaufman reports that acetic acid can be used as a complexing agent (see, e.g., column 6, lines 5-8). Further, Kaufman reports that the pH of the slurry can be "adjusted" using known acids and bases (column 8, lines 28-30). Significantly, Kaufman does not teach or suggest the use of an acid/conjugate base pair. The Office Action asserts that it is known in the art that acetic acid is a buffer. Applicants disagree and respectfully request that the Patent Office cite a reference supporting this proposition or provide an affidavit as required by Rule 104 (See MPEP § 2144.03(C)). Although acetic acid may be a component of a buffer, acetic acid, by itself, is not a buffer. A buffer contains both a weak acid and its conjugate weak base (see, e.g., *Hawley's Condensed Chemical Dictionary*, 13th Ed., 169, Revised by R. J. Lewis, Sr. New York: Wiley, 1997 (attached)). For example, a buffer with an acidic pH can be made of a weak acid, such as acetic acid, and a soluble salt of its anion, such as sodium acetate. Kaufman simply does not teach or suggest a working liquid that comprises a buffer.

Further, Hudson and Hirabayashi do not teach or suggest the use of buffer, nor does the Office Action allege that they do. Thus, Kaufman, Hudson, and Hirabayashi do not teach or suggest a working liquid that comprises a buffer as recited in Applicants' claims. For at least this

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reason, the rejection of claims 16, 18-39, and 41-43 under 35 USC § 103(a) as allegedly being obvious over Kaufmann in view of Hudson or Hirabayashi should be withdrawn.

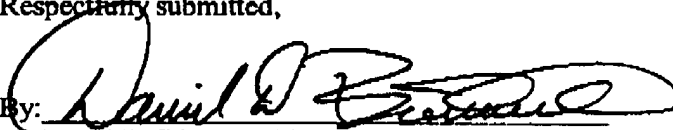
II. Conclusion

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. The Examiner is invited to contact Applicants' undersigned representative with any questions concerning Applicants' application

Respectfully submitted,

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